

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte BRUCE A. HUNTER

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Appeal No. 2000-1623  
Application 09/030,385

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ON BRIEF

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Before CALVERT, FRANKFORT, and NASE, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 to 5, all the claims in the application.

The claims on appeal recite an insert adapted to be inserted in a T-shaped slot (claims 1 to 3 and 5), or a panel assembly (claim 4), and are reproduced in the corrected Appendix A filed on October 27, 2000.<sup>1</sup>

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<sup>1</sup> We note that in claim 5, --can be-- apparently should be inserted after "configuration" (line 3).

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The references applied in the final rejection are:

Johnstonbaugh	4,615,448	Oct. 7,
1986		
Grossen	5,138,803	Aug. 18,
1992		

The appealed claims stand finally rejected on the following grounds:

(1) Claims 1 to 5, unpatentable over Johnstonbaugh in view of Grossen, under 35 U.S.C. § 103(a).

(2) Claims 4 and 5, unpatentable for failure to comply with 35 U.S.C. § 112, second paragraph.<sup>2</sup>

Rejection (1)

Considering claim 1, the only independent claim, the examiner finds, in effect, that all the limitations of that claim are readable on Johnstonbaugh except for the requirement that the insert be "formed of resilient material". The examiner concludes, however, that the claimed subject matter

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<sup>2</sup> The final rejection states that this rejection applies to claims 1 to 5, but on page 4 of the answer the examiner agrees that it is only applicable to claims 4 and 5.

would have been obvious in view of Grossen's teaching of an insert made of resilient material.

Appellant argues that, even if combined, Johnstonbaugh and Grossen would not teach or suggest the claimed invention. After fully considering the record in light of the arguments presented in the brief, reply brief, and examiner's answer, we find ourselves in agreement with the appellant.

Claim 1 requires, inter alia:

said insert ... having ... a pair of opposed legs ... , said legs having flanges on the outwardly extending ends thereof, said flanges facing away from each other and spaced outwardly, away from the surface of said panel on opposite sides of said slot [,] when said insert is positioned in said slot [,] a distance adapted to removably support, between a pair of adjacent flanges which face each other, a sheet of display material between said exposed surface of said panel and said flanges.

In the Johnstonbaugh apparatus, the panel 10 may include a surface covering 46 affixed to either or both surfaces (col. 3, lines 5 to 7). The legs 40, 41 of the insert have flanges ("hooks") 44, 45 at their outer ends, which engage the lips 27, 28 of the opening of the T-slot 11 to increase its strength and provide a better aesthetic appearance (col. 2, lines 48 to 52; col. 2, line 65, to col. 3, line 2). The

examiner takes the position that this structure meets the above-quoted portion of claim 1 in that the Johnstonbaugh flanges are spaced away from the face of the panel a sufficient distance to accommodate the thickness of panel 46 (answer, page 6), but we do not believe that claim 1 can be read on Johnstonbaugh in this manner because

the core of Johnstonbaugh's panel and the surface covering(s) 46 affixed thereto together constitute a panel; the core by itself cannot be reasonably interpreted as being the panel recited in claim 1.

"[D]uring examination proceedings, claims are given their broadest reasonable interpretation consistent with the specification". In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). In the present case, the flanges of appellant's insert are disclosed as being spaced beyond the surface of the panel so that they can support a removable sheet of material. In light of this disclosure, we do not consider it reasonable to interpret the claim 1 expression "the surface of said panel" so broadly as to include the surface of a core of a panel to which, as in Johnstonbaugh, a

surface covering is affixed; such an interpretation would be inconsistent with appellant's specification and the entire purpose of appellant's claimed invention. Rather, in Johnstonbaugh the surface of the panel is the outer surface of covering 46, so that the flanges 44, 45 of Johnstonbaugh engage the surface of the panel rather than being "spaced outwardly, away from" this surface as required by claim 1. Since there is no disclosure in Johnstonbaugh of the claimed spacing, nor any disclosure in Grossen which would have taught or suggested such spacing, we conclude that claim 1 is unobvious over the combination of Johnstonbaugh and Grossen. It follows that dependent claims 2 to 5 are likewise unobvious.

Accordingly, rejection (1) will not be sustained.

Rejection (2)

The test for compliance with the second paragraph of § 112 is whether, when a claim is read in light of the specification, one skilled in the art would understand the bounds of the claim, i.e., would reasonably be apprised of the scope of the invention. Miles Labs. Inc. v. Shandon Inc., 997 F.2d 870, 875, 27 USPQ2d 1123, 1126 (Fed. Cir. 1993), cert.

denied, 510 U.S. 1100 (1994). In general, lack of antecedent basis for a term in a claim may render the claim invalid under § 112, second paragraph. In re Altenpohl, 500 F.2d 1151, 1156, 183 USPQ 38, 43 (CCPA 1974).

In the present case, the examiner identifies a number of expressions in claims 4 and 5 as having no antecedent basis, and appellant does not specifically dispute these. The examiner also finds claim 4 to be indefinite in that claim 4 recites "A panel assembly according to claim 1", whereas claim 1 is drawn to "An insert adapted to be inserted in a T-shaped slot extending along an exposed surface of a panel"; according to the examiner, "it is unclear if the applicant is positively claiming the panel in combination with the insert" (final rejection, page 2). We consider this ground of the rejection to be well taken, in that we do not consider that one of ordinary skill would be reasonably apprised of whether claim 4 includes within its scope both a panel and inserts, or only inserts.

Rejection (2) will therefore be sustained.

Statement Pursuant to 37 CFR 1.196(c)

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Pursuant to 37 CFR 1.196(c), we state that, in the absence of new references or grounds of rejection, claims 4 and 5 may be allowed if amended to return them to the form in which they were when the application was originally filed. As provided in the rule, appellant has the right to amend in conformity with this statement; such amendment must be filed within the period allowed for seeking court review under 37 CFR 1.304. See MPEP § 1213.01 (Feb. 2000).

#### Conclusion

The examiner's decision to reject claims 1 to 5 under 35 U.S.C. § 103(a) is reversed, and to reject claims 4 and 5 under 35 U.S.C. § 112, second paragraph, is affirmed. A statement is made pursuant to 37 CFR 1.196(c).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

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Administrative Patent Judge	)	
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